

**REMARKS**

Claims 1-16 are currently pending in the subject application, and are presently under consideration. Claims 1-16 are rejected. Favorable reconsideration of the application is requested in view of the amendments and comments herein.

A New Declaration under 35 C.F.R. §1.131 is being filed with this Amendment. It is respectfully submitted that the New Declaration cures the deficiencies of the declaration filed on June 20, 2005. Specifically, all inventors named in the Application have signed the New Declaration.

Furthermore, it is respectfully submitted that the finality of this Office Action should be withdrawn. The Office Action contends that Applicant's amendment filed on June 20, 2005 ("June 20 Amendment") necessitated new grounds for rejection, justifying the making of the current Office Action final. However, it is respectfully submitted that the claims amended in the June 20, 2005 amendment were amended to address formal matters only. The scope of the claims was not affected. Additionally, in the present Office Action, the Examiner has not cited any new art or reasons for rejection which were necessitated by the amendment of the claims. Thus, the finality of the Office Action should be withdrawn.

Additionally, as it will be shown below, the Examiner has not addressed some of the arguments made by Applicant in the June 20 Amendment. Consequently, Applicant respectfully requests that the Examiner reconsider the arguments, and issue an appropriate response.

**I     U.S. Patent Publication 2003/0005291 to Burn is Not Prior Art**

The Office Action has rejected claims 1-16 Under 35 U.S.C. §103 based on U.S. Patent Publication No. 2003/0005291 to Burn ("Burn") in combination with Muftic, U.S. Patent No. 5,943,423 ("Muftic"). As stated above, a New Declaration under 35 C.F.R. §1.131 is being filed with this Amendment ("New Declaration"). It is respectfully submitted that the New Declaration presents facts sufficient to antedate the Burn reference. Specifically, the showing of facts in the attached New Declaration and exhibits establishes conception of the present invention in this

country prior to the effective date (December 20, 2000) of Burn to a constructive reduction to practice of the present application, coupled with due diligence. Therefore, it is respectfully submitted that Burn should be withdrawn as prior art and, as a result, rejections in the Office Action relying on Burn should be withdrawn.

Submitted as exhibit A ("Exhibit A") of the New Declaration shows conception of the invention prior to the effective date of Burn. Conception is complete when an idea is defined clearly enough in an inventors mind that merely ordinary skill would be necessary to reduce the invention to practice. *Seewall v. Walters*, 21 F.3d 411, 415, 30 U.S.P.Q.2d 1356, 1359 (Fed. Cir. 1994). The averment in the New Declaration that the paper in the form of a PowerPoint® presentation corresponding to Exhibit A was written by a named inventor prior to December 20, 2000 is sufficient to establish conception prior to the effective date of Burn. See MPEP 715.07. For example, on page 15 of the Exhibit A states that a private identity key is generated on the token itself and never leaves, keys are returned wrapped in the public key of the owner, and can only be recovered on a specific token. One or ordinary skill in the art could reduce at least independent claims 1 and 9 to practice without undue experimentation in view of Exhibit A.

Additionally, the New Declaration establishes diligence from just prior to December 20, 2000 until the date of constructive reduction to practice when the application was filed on December 19, 2001. The New Declaration demonstrates that a named inventor completed a second written description in the form of a PowerPoint® presentation (Exhibit B) on January 4, 2001. Further, the inventors submitted an invention disclosure (Exhibit C) on February 20, 2001. On April 27, 2001, the invention was forwarded to the Assignee's attorney, Donald E. Stout, for preparation of a patent application, as evidenced by Exhibit D. A draft of the patent application was sent to the Assignee on June 25, 2001 as evidenced by Exhibit E. Changes of the draft were suggested, and the changes were forwarded to George N. Stevens, Assignee's attorney on October 18, 2001, as evidenced by Exhibit F. A second draft of the Application was forwarded to the Assignee on October 24, 2001, as evidenced by Exhibit G. A patent application was submitted to the United States Patent and Trademark Office on December 19, 2001. It is respectfully submitted that the patent attorneys exercised reasonable diligence in drafting and

filing the present application. Reasonable diligence does not require that a patent attorney engaged in normal practice to concentrate on any one application to the exclusion of others. *Watkins v. Wakefield*, 443 F.2d 1207, 170 U.S.P.Q. 274, 275 (C.C.P.A. 1971). Thus the Application has established conception prior to Burn's effective date of December 20, 2000, and diligence from the conception to the constructive reduction to practice on December 19, 2001. Accordingly, in view of the above arguments, the Declaration under 37 CFR §1.131 is entitled to antedate Burn.

## **II. The Rejection of Claims 1-16 Under 35 U.S.C. §103(a) Should be Withdrawn**

Claims 1-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Muftic in view of Burn. Withdrawal of this rejection is respectfully requested for the reasons stated above as the Burn reference is not prior art to the present application. Additionally, the rejection should be withdrawn for at least the following reasons.

It is respectfully submitted that the Examiner has not responded to the arguments made in the June 20 Amendment regarding claim 1. Thus, the arguments made in the June 20 Amendment shall be reiterated. Accordingly, Applicant respectfully requests an appropriate response to the following arguments.

In regards to claim 1, Muftic does not teach or suggest reading a token ID and a signature certificate from a token, as recited in claim 1. The phrase "signature certificate" as recited in claim 1, refers to a digital certificate that contains an extension that asserts that the digital signature can be used as a personal digital signature of a user or entity, and that the user or entity providing the signature certificate is the only entity that has a private key matching the public key in the certificate. It is to be appreciated that the signature certificate also contains a signature of a certification authority associated with a public key infrastructure. It is respectfully submitted that the definition of "signature certificate" is well known in the art of public key infrastructures. Muftic discloses sending a user public key certificate stored on a token with a user identification and a user random number to a network resource (See Muftic Col. 5, Lines

36-38). However, Muftic does not teach or suggest that the user public key certificate could be a signature certificate. Thus, Muftic fails to teach or suggest each and every element of claim 1.

Additionally, Applicant agrees with the Examiner that Muftic does not teach or suggest creating a certificate, wherein the certificate is wrapped with a public key associated with a token ID and digitally signing the certificate/private key using a signature certificate of the certificate authority, downloading the certificate/private key to a token and decrypting the certificate/private key using a private key stored on the token, as recited in claim 1. However, assuming *arguendo* that Burn is prior art, Burn also fails to teach or suggest reading a token ID and a signature certificate from a token, as recited in claim 1. Thus, Muftic and Burn taken individually or in combination, do not teach or suggest each and every element of claim 1. Accordingly, claim 1 is patentable over the cited art.

Claims 2-8 depend directly or indirectly from claim 1 and are patentable over the cited prior art for substantially the same reasons as claim 1, and for the specific elements recited therein. Accordingly, claims 2-8 are patentable over the cited art.

Claim 9 is not made obvious by Muftic in view of Burn for substantially the same reasons as claim 1. As stated above with respect to claim 1, Burn is not prior art. Thus, the rejection of claim 9 based on the combination of Muftic and Burn must be withdrawn. Accordingly, claim 9 is patentable over the cited art.

Claims 10-16 depend from claim 9 and are patentable over the cited prior art for substantially the same reasons as claim 9 and for the specific elements recited therein. Accordingly, claims 10-16 are patentable over the cited art.

For the reasons described above, claims 1-16 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.


**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Applicant respectfully requests reconsideration of this application and that the application be passed to issue.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

Date 11/21/05

  
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